



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE GOUGH

Application for Patent

Filed September 21, 1999

Serial No. 09/400,708

Examiner Thong H. Vu, Art Unit 2142

**FOR: METHOD AND ARTICLE OF MANUFACTURE FOR A SUB-BROWSER
APPLICATION PROGRAM STORED IN AN ELECTRONIC MESSAGE**

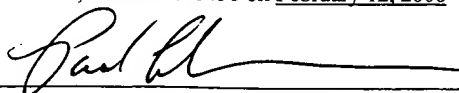
APPEAL BRIEF

02/16/2006 WASFAW1 00000016 503539 09400708
01 FC:2402 250.00 DA

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Box Appeal, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 12, 2006

Signature: _____



Paul L. Hickman

TABLE OF CONTENTS

	<u>Page No.</u>
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES.....	2
III. STATUS OF THE CLAIMS	3
IV. STATUS OF THE AMENDMENTS	4
V. SUMMARY OF CLAIMED SUBJECT MATTER	5
VI. BRIEF HISTORY OF THE PROSECUTION OF THIS APPLICATION	7
VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	8
VIII. GROUPING OF THE CLAIMS.....	9
A. Group A – Claims 1-3, 5-8, 11-14 stand or fall with claim 1	9
B. Group B – Claims 16-22 stand or fall with claim 16.....	9
C. Claim 15 stands or falls on its own.....	9
IX. THE CITED ART	10
X. ARGUMENTS.....	11
A. Group A - Claims 1-3, 5-8, 11-14.....	11
B. Group B – Claims 16-22.....	14
C. Claim 15.....	15
XI. CONCLUSION.....	17
XII. CLAIMS APPENDIX.....	18
XIII. EVIDENCE APPENDIX.....	23
XIV. RELATED PROCEEDINGS APPENDIX	24

I. REAL PARTY IN INTEREST

The real party in interest is Neostar, Inc., by assignment.

II. RELATED APPEALS AND INTERFERENCES

The following appeals of applications commonly owned with the present application may be related:

Atty. Dock. No.	USSN	Filed	Status
NEO1P019	09/400,711	09/21/99	No Opinion to date
NEO1P020	09/400,712	09/21/99	No Opinion to date
NEO1P029	09/493,468	01/28/00	No Opinion to date
NEO1P036	09/493,468	11/22/00	No Opinion to date

III. STATUS OF THE CLAIMS

Claims 1-3, 5-8 and 11-22 (renumbered by the Examiner as claims 1-19) are rejected.
Claims 4, 9 and 10 have been cancelled. No claims have been allowed.

IV. STATUS OF THE AMENDMENTS

There has been no amendment after the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In one embodiment, set forth by way of example and not limitation, a method for executing an application program associated with an electronic message includes initializing at least one application program by automatically retrieving code from a server over a network after an electronic message received over the network is opened (*e.g.* Fig. 4, item 400) for viewing by a user. The application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message. Then, the application program of the electronic message is automatically executed within the context of the electronic message (*e.g.* Fig. 6). *See generally*, for example, Fig. 4 and descriptions and pseudocode on page 9, line 6 to page 10, line 22 for exemplary algorithms and Fig. 6 as an operating example.

In another embodiment, set forth by way of example and not limitation, a computer program embodied on a computer readable medium (*e.g.* Fig. 3, items 314, 316, 320, etc.) for executing an application program associated with an electronic message includes a segment at least partially within an electronic message for initializing at least one application program by automatically retrieving code from a server over a network after the electronic message is received over the network and is opened (*e.g.* Fig. 4, item 400) for viewing by a user. The application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message. Then, a code segment automatically executes the application program of the electronic message within the context of the electronic message (*e.g.* Fig. 6). *See generally*, for example, Fig. 3 and descriptions on page 8, line 23 to page 9, line 5; and Fig. 4 and descriptions and pseudocode on page 9, line 6 to page 10, line 22 for exemplary algorithms and Fig. 6 as an operating example.

In another embodiment, set forth by way of example and not limitation, an electronic message includes a data object including text (*e.g.* Fig. 11 and pseudocode on page 16, lines 29-35) that had been received over a network and stored on a computer having an electronic mail

program (*e.g.* Fig. 4, item 400, and descriptions on page 9, lines 16-25) and an application program object initialized, at least in part, by being automatically received, at least in part, over the network after the receipt and opening for viewing of the data object (*e.g.* Fig. 4, item 400). Then, the application program object is automatically executed (*e.g.* Fig. 6). *See generally*, for example, Fig. 4 and descriptions and pseudocode on page 9, line 6 to page 10, line 22 for exemplary algorithms; Fig. 6 as an operating example; and Fig. 11 page 16, line 10 to page 17, line 12 for descriptions and pseudocode of data objects.

VI. BRIEF HISTORY OF THE PROSECUTION OF THIS APPLICATION

A non-final Office Action was sent by the Examiner on September 24, 2003, rejecting all claims. Appellant filed an Amendment on February 24, 2004 with a two-month extension of time. A Notice of Non-Compliant Amendment was sent on March 8, 2004, complaining of not providing proper status identifiers for all claims. An Amendment was filed by Appellant on April 2, 2004, responding to the notice of Non-Compliant Amendment and providing proper status identifiers for all claims. The Examiner left a voice mail for the Appellant on June 2, 2004, indicating that the application would be allowable if a Terminal Disclaimer were filed. On June 4, 2004, Appellant had a telephonic interview with the Examiner, and filed a Terminal Disclaimer with the USPTO. The Examiner made the interview of record with an Interview Summary. On September 27, 2004, a Notice of Allowance and Fee(s) Due was mailed from the USPTO. On the same day, Appellant filed a Request for Continued Examination (RCE), along with an IDS Form 1449 citing four references. On July 11, 2005, the Examiner finally rejected all of the claims based upon new art.

There were a number of procedural errors made by the Examiner in the most recent final rejection. First, the Examiner did not consider or sign the IDS Form 1449 for the references cited along with Appellant's RCE. Secondly, the Examiner apparently and confusingly renumbered the claims that he rejected. Applicant will refer to the original claim numbers so as to prevent confusion. Thirdly, the Examiner improperly made a first action final. This is because the claims presented in the RCE had been allowed by the Examiner, not previously rejected. As such, Appellants never had a chance to argue against a new rejection to previously allowable claims. Nonetheless, Appellants have the right to Appeal, as the claims of the application had been rejected more than once during the prosecution history.

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The sole ground of rejection to be reviewed on appeal is: *was the rejection of claims 1-19 (as renumbered from claims 1-3, 5-8 and 11-22) under 35 U.S.C. 102(e) as being anticipated by Bendinelli in error?*

VIII. GROUPING OF THE CLAIMS

Appellant uses the original claim numbering from this point on to reduce confusion. The following claims stand or fall together:

- A. Group A – Claims 1-3, 5-8, 11-14 stand or fall with claim 1
- B. Group B – Claims 16-22 stand or fall with claim 16
- C. Claim 15 stands or falls on its own

IX. THE CITED ART

U.S. Patent No. 6,061,719 of Bendinelli et al. (hereafter "Bendinelli") teaches that Uniform Resource Locators (URLs) or other network information identifiers that are transmitted with television signals can be used to permit web content to be displayed in synchronization with television programming. In an illustrative embodiment, URLs are embedded in a closed caption portion of a transmitted television signal, and delimited from the closed caption text using predetermined delimiting characters. A decoder extracts the URLs from the television signal, and supplies the URLs to a retrieval device which automatically retrieves corresponding web pages or other similar information over a network. The retrieved web pages are then displayed to a viewer in synchronization with related programming in the television signal. The retrieval device may be a set-top box associated with a television set that displays both a retrieved web page and the corresponding television picture portion of the television signal. Alternatively, the retrieval device may be a computer which retrieves and displays a web page, while the corresponding television picture is displayed on a television set.

Applicant notes that Bendinelli is only potentially prior art only under §102(e), and reserves the right to swear behind this reference at a future date.

X. ARGUMENTS

For the reasons set forth below, Appellant contends that: *the rejection of claims 1-19 (as renumbered from claims 1-3, 5-8 and 11-22) under 35 U.S.C. 102(e) as being anticipated by Bendinelli was in error and should be reversed.*

A. Group A - Claims 1-3, 5-8, 11-14

Claim 1 is reproduced below:

1. A method for executing an application program associated with an electronic message, comprising:

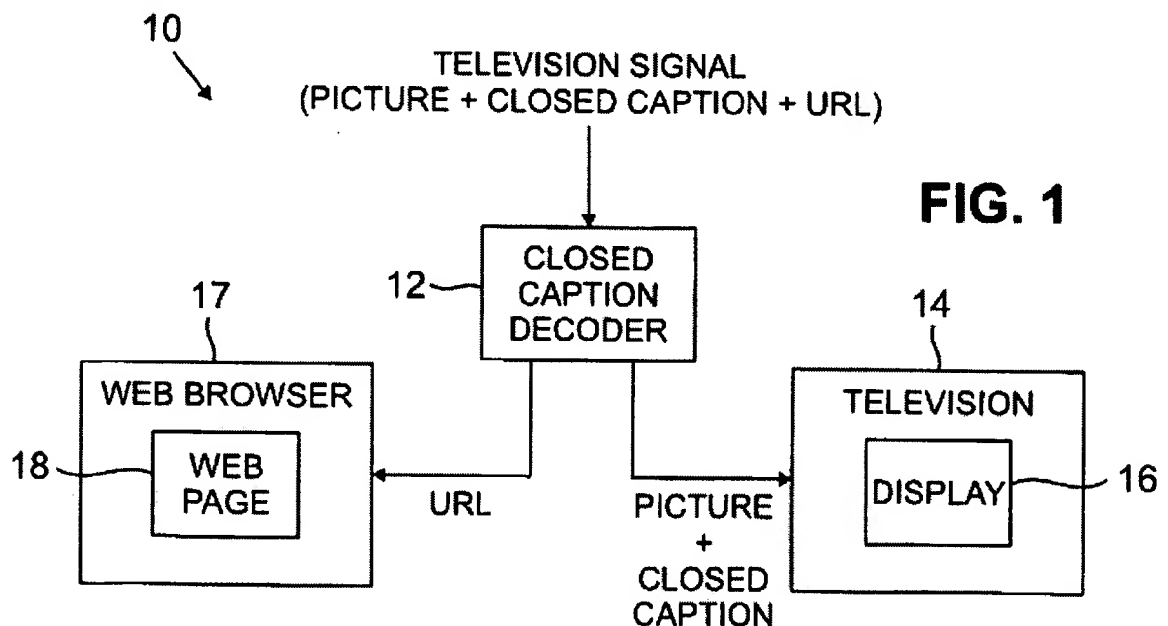
initializing at least one application program by automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user, wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message; and

automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof. (emphasis added)

It is hard to know where to start with this one. Applicant is claiming an electronic message with an automatically executing application program which is downloaded over a network. The Examiner has rejected all claims in view of the disclosure of col. 3, lines 12-35 and claims 15 and 35 of Bendinelli, which appears to be wholly unrelated to Appellant's claimed inventions.

Bendinelli, col. 3, lines 12-35, and the referenced Fig. 1, are reproduced below:

FIG. 1 shows a system 10 for implementing presentation of web content in conjunction with related television programming in accordance with the invention. The system 10 includes a closed caption decoder 12 and a television 14. A television signal transmitted from a broadcast transmitter includes a video or "picture" portion, a closed caption text stream, and one or more URLs. The URLs are transmitted so as to coincide with the television programming represented by the picture portion of the signal. For example, when the programming corresponds to an advertisement, the corresponding transmitted URL may identify a web site of the company or product being advertised. Similarly, news programming may be transmitted with URLs identifying one or more web sites which describe various news items in greater detail, and music video programming may be transmitted with URLs identifying web sites of the recording company, artist or studio associated with the music video. Numerous other relationships between the transmitted programming and URLs are of course possible. The television signal may be received in the system 10 in a conventional manner via an antenna, cable network, satellite receiver or other type of conventional signal reception device, and is applied to an input of the closed caption decoder 12 as shown.



Claims 15 and 35 of Bendinelli are reproduced below:

15. An apparatus for accessing information over a computer network, comprising:
a decoder for processing at least one network information identifier transmitted with a television signal; and
a display device coupled to an output of the decoder and receiving at least a portion of the television signal therefrom, wherein the network information identifier is utilized to automatically retrieve information over the network, such that the received information is displayed to a viewer in conjunction with a display on the display device of related programs in the television signal, and the viewer is permitted to select continued display of currently-displayed retrieved information corresponding to a particular network information identifier, and wherein selection of continued display of the currently-displayed retrieved information automatically interrupts display of additional retrieved information corresponding to at least one subsequently-received network information identifier.

35. An apparatus for accessing information over a computer network, comprising:
a decoder for processing at least one network information identifier transmitted with a television signal; and
a display device coupled to an output of the decoder and receiving at least a portion of the television signal therefrom, wherein the network information identifier is utilized to automatically retrieve information over the network, such that the retrieved information is displayed to a viewer in conjunction with a display on the display device of related programming in the television signal, and wherein the decoder prevents the retrieval and display of information corresponding to a particular network information identifier if the particular network information identifier has a designated predetermined form.

It is clear from the very disclosures that the Examiner is relying upon that Bendinelli is both disclosing and claiming a television system which displays associated web site information. As such, Bendinelli does not disclose a number of limitations of claim 1 including: an electronic message; automatically retrieving code over a network after an electronic message is opened; the receiving of an application program over the network as the result of opening an

electronic message; and/or automatically executing the application program within the context of the electronic message. It should also be noted that the television of Bendinelli is a passive display device, so there is no way that it can “open” an electronic message, even if one were displayed, and the television signal is apparently not even networked.

The Examiner has therefore not even made a *prima facie* case of anticipation. The Federal Circuit has stated that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.”¹ The Examiner has not even come close to meeting this burden.

There is no conceivable way that Bendinelli is §102(e) anticipatory prior art with regards to Appellant’s claim 1 because it lacks at least one limitation of that claim. The rejection is clearly in error, and the rejection of the Group A claims should be reversed.

B. Group B – Claims 16-22

Claim 16 is reproduced below:

16. An electronic message comprising:

a data object including text that had been received over a network and stored on a computer having an electronic mail program; and

an application program object initialized, at least in part, by being automatically received, at least in part, over the network after the receipt and opening for viewing of the data object, the application program object being automatically executed on the computer after the initialization thereof. (emphasis added)

Many of the comments made above with respect to the claims of Group A also apply to the claims of Group B, and are incorporated herein. Bendinelli does not disclose a number of limitations of claim 16 including: an electronic message, a data object including text stored on a computer having an electronic mail program, an application program initialized by

¹ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 at 313 (Fed. Cir. 1983)

being automatically received over a network after the data object is opened for viewing, and/or automatically executing the application object after initialization.

Again Bendinelli is clearly not §102(e) anticipatory prior art to Appellant's claim 16, since Bendinelli lacks at least one limitation of that claim.² The rejection is clearly in error, and the rejection of the Group B claims should be reversed.

C. Claim 15

Claim 15 is reproduced below:

15. A computer program embodied on a computer readable medium for executing an application program associated with an electronic message, comprising:

a segment at least partially within an electronic message for initializing at least one application program by automatically retrieving code from a server over a network after the electronic message is received over the network and is opened for viewing by a user, wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message; and

a code segment automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof. (emphasis added)

Again, many of the comments made above with respect to the claims of Groups A and B also apply to claim 15, and are incorporated herein. Bendinelli does not disclose a number of limitations of claim 15 including: an electronic message, a segment within an electronic message for initializing an application program, automatically retrieving code over a network after opening an viewing an electronic message, and/or automatically executing the application program within the context of the electronic message.

² *Id.*

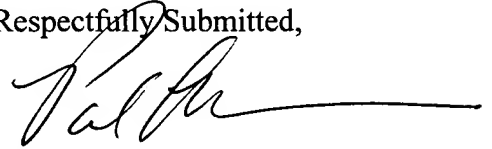
Again, Bendinelli is clearly not 102(e) anticipatory prior art to Appellant's claim 15, since Bendinelli lacks at least one limitation of that claim.³ The rejection is clearly in error, and the rejection of claim 15 should be reversed.

³ *Id.*

XI. CONCLUSION

As noted, the cited reference clearly cannot anticipate the pending claims. Accordingly, Applicant believes the rejections to be clearly in error, and respectfully requests the Board of Appeals and Interferences to reverse the Examiner's rejections of the claims on appeal, and to consider the references cited in Appellant's Form 1449.

Respectfully Submitted,

A handwritten signature in dark ink, appearing to read 'Paul L. Hickman', with a long horizontal flourish extending to the right.

Paul L. Hickman
Reg. No. 28,516

Correspondence Address:

Customer No. 45965

Telephone: 650-333-0180

XII. CLAIMS APPENDIX

1. A method for executing an application program associated with an electronic message, comprising:

initializing at least one application program by automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user, wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message; and

automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof.

2. The method as set forth in claim 1, wherein the electronic message is opened by the user by clicking on an identifier of the electronic message in an electronic mail browser.
3. The method as set forth in claim 1, wherein the application program includes an applet.
5. The method as set forth in claim 1, wherein the execution of the application program includes a functionality based on a text included with the electronic message.

6. The method as set forth in claim 1, wherein the execution of the application program includes the display of streaming video over the network.

7. The method as set forth in claim 1, wherein the execution of the application program includes outputting an advertisement.

8. The method as set forth in claim 1, wherein the application program is executed on a network browser.

11. The method as set forth in claim 1, wherein the execution of the application program includes the ability to send a new electronic message over the network.

12. The method as set forth in claim 1, wherein the execution of the application program produces at least one of a pictorial, graphic, animated, video and audio display.

13. The method as set forth in claim 1, wherein the application program includes markup language which calls an object-oriented computer language.

14. The method as set forth in claim 13, wherein the object-oriented computer language

includes an applet.

15. A computer program embodied on a computer readable medium for executing an application program associated with an electronic message, comprising:

a segment at least partially within an electronic message for initializing at least one application program by automatically retrieving code from a server over a network after the electronic message is received over a the network and is opened for viewing by a user, wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message; and
a code segment automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof.

16. An electronic message comprising:

a data object including text that had been received over a network and stored on a computer having an electronic mail program; and

an application program object initialized, at least in part, by being automatically received, at least in part, over the network after the receipt and opening for viewing of the data object, the application program object being automatically executed on the computer after the initialization thereof.

17. An electronic message as recited in claim 16 wherein the application program object develops at least one of a pictorial, graphic, animated, video and audio display.

18. An electronic message as recited in claim 17 wherein the at least one of the pictorial, graphic, animated, video and audio display is streamed to the application program over the network.

19. A computer program embodied on a computer readable medium for executing an application program associated with an electronic message as recited in claim 15 wherein at least one code segment resides, at least in part, in a browser software.

20. A computer program embodied on a computer readable medium for executing an application program associated with an electronic message as recited in claim 19 wherein the browser software includes the functionality of running a Java applet.

21. A computer program embodied on a computer readable medium for executing an application program associated with an electronic message as recited in claim 20 wherein the application program develops at least one of a pictorial, graphic, animated, video and audio display.

22. A computer program embodied on a computer readable medium for executing an application program associated with an electronic message as recited in claim 21 wherein the at least one of the pictorial, graphic, animated, video and audio display is streamed to the application program over the network.

XIII. EVIDENCE APPENDIX

NONE

XIV. RELATED PROCEEDINGS APPENDIX

NONE